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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/954,856	09/17/2001	Marcy Makarewicz	IMET0066	8747

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GLENN PATENT GROUP  
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EXAMINER

KREMER, MATTHEW J

ART UNIT	PAPER NUMBER
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3736

DATE MAILED: 01/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/954,856

Applicant(s)

MAKAREWICZ ET AL.

Examiner

Matthew J Kremer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-48 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Priority*

1. It is noted that this application appears to claim subject matter disclosed in prior copending Application No. 09/563,782, filed 5/2/2000 and copending Application No. 09/631,440, filed 8/2/2000. A reference to the prior application must be inserted as the first sentence of the specification of this application or in an application data sheet (37 CFR 1.76), if applicant intends to rely on the filing date of the prior application under 35 U.S.C. 119(e) or 120. See 37 CFR 1.78(a). Also, the current status of all nonprovisional parent applications referenced should be included.

If the application is a utility or plant application filed on or after November 29, 2000, any claim for priority must be made during the pendency of the application and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior application. See 37 CFR 1.78(a)(2) and (a)(5). This time period is not extendable and a failure to submit the reference required by 35 U.S.C. 119(e) and/or 120, where applicable, within this time period is considered a waiver of any benefit of such prior application(s) under 35 U.S.C. 119(e), 120, 121 and 365(c). A priority claim filed after the required time period may be accepted if it is accompanied by a grantable petition to accept an unintentionally delayed claim for priority under 35 U.S.C. 119(e), 120, 121 and 365(c). The petition must be accompanied by (1) a surcharge under 37 CFR 1.17(t), and (2) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2) or (a)(5) and the date the

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claim was filed was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional. The petition should be directed to the Office of Petitions, Box DAC, Assistant Commissioner for Patents, Washington, DC 20231.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-48 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "minimize" in claim 1, line 16 and claim 11, line 9 is a relative term which renders the claim indefinite. The term "minimize" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. The term "natural position" in claim 1, line 14 is a relative term which renders the claim indefinite. The term "natural position" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. The term "minimizing" in claim 30, lines 3, 6, and 8 is a relative term which renders the claim indefinite. The term "minimizing" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite

degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-4, 7-8, 11-18, 21, and 23-27 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent 6,026,313 to Kexin. Kexin teaches a base 60 with apertures, an elbow support 62, an arm and wrist support 64, and a hand support 10. (Fig. 11 of Kexin). In regard to claims 2-3 and 12-13, the object of the invention to obtain reproducible measurements by fixing a measured position and settling the contact pressure. (column 2, lines 30-34 of Kexin). In regard to claims 4 and 14-15, the structure 16a in Figs 7-8 of Kexin is mounted in the holes of base 60 (shown in Fig. 11 of Kexin) and is therefore considered part of the base. Structure 16a houses the optic fiber. In regard to claims 7 and 25, presser member 64 is part of the wrist support which provides a plurality of contours and heights due to its malleable nature and the dimensions of the patient's arm. (Fig. 11 of Kexin). In regard to claim 8, the hand support is slideably adjustable. In regard to claim 16, an arm is being examined. (Fig.

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11 of Kexin). In regard to claims 21 and 26, a spring is used for adjusting elbow height.

(Fig. 11 of Kexin).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 6 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,026,313 to Kexin as applied to claims 1 and 21, and further in view of U.S. Patent 3,785,196 to Smith. Kexin teaches the use of springs to adjust the elbow height. (Fig. 11 of Kexin). Kexin does not teach the use of shims or spacers to adjust the elbow height. It is well known in the art that spacers or shims are suitable substitutions for springs. (column 4, lines 18-21 of Smith). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to substitute the spacer of Smith for the spring since Smith teaches that they are suitable substitutions for each other. A series of spacers would be necessary since Kexin teaches the elbow support is adjustable and different sizes of spacers would be needed to make the elbow support 62 adjustable.

8. Claims 5 and 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,026,313 to Kexin as applied to claims 1 and 17, and further in view of U.S. Patent 6,088,605 to Griffith et al., and further in view of U.S. Patent 5,195,985 to Hall. Kexin teaches an elbow support 62. (Fig. 11 of Kexin). Kexin does not teach that the elbow support includes a depression to accommodate the shape of the elbow. It is known in the art that when a specimen, such as an arm, is examined, the supporting platform is configured to the shape of that specimen. For example, Griffith et al. teaches an apparatus in which an arm is set. (Fig. 1 of Griffith et al.). The depressions increase the patient's comfort when the arm is placed on the examining apparatus. (column 10, lines 50-52 of Hall). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of Kexin to include a depression to accommodate the elbow as disclosed in Griffith et al. since such a depression increases the comfort of the patient. In regard to claims 5 and 20, it is well known that different specimens have different dimensions. An example is provided in Kexin which involves different probes for different sizes of hands. (column 5, lines 21-29 of Kexin). Using different sizes of elbow depressions would ensure the patient's comfort that is desired while accommodating the different physical dimensions of each patient. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the elbow depressions of the combination so as to have a plurality of different shapes available since using different sizes of elbow depressions would ensure the patient's comfort while accommodating the different physical dimensions of each patient.

9. Claims 9 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,026,313 to Kexin as applied to claims 1 and 17. Kexin does not explicitly teach that all the supports are custom-fabricated. Kexin teaches that the different hand supports are prepared for different measuring tissues for higher accurate readings. (column 5, lines 21-29 of Kexin). Kexin implies that the hand support can be changed to accommodate a particular patient. The customization of a probe to a body part would also contribute to the patient's comfort during the measurements. The customization of the structure that holds the body part to a particular patient would ensure the patient's desired comfort and higher accurate readings while accommodating the physical differences in each patient. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use customized supports in the combination since customization would ensure the patient's comfort and higher accuracy readings while accommodating the different physical dimensions of each patient.

10. Claims 10 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,026,313 to Kexin as applied to claims 1 and 11, and further in view of U.S. Patent 5,368,025 to Young et al. Kexin does not specify a type of material for the structures. It is well known in the art that structures that support body parts are made of elastomeric polymers. (claim 1 of Young et al.). Such elastomeric polymeric parts are manufactured at relatively low costs, are comfortable to the patient's skin, and



would fulfill the structural requirements for the structure disclosed by Kexin. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use elastomeric polymers in the construction of the structure of Kexin since Kexin requires the device to be made of some material and Young et al. teaches one such material which can be manufactured at a relatively low cost and is comfortable to the patient's skin.

11. Claims 30-39 and 44-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,026,313 to Kexin in view of U.S. Patent 6,039,697 to Wilke et al. Kexin teaches a base 60 with apertures, an elbow support 62, an arm and wrist support 64, and a hand support 10. (Fig. 11 of Kexin). Kexin teaches that the object of the invention to obtain reproducible measurements by fixing a measured position and settling the contact pressure, i.e., minimizing variations in pressure and placement. (column 4, lines 30-34 of Kexin). Kexin does not teach minimizing surface temperature transients. Kexin teaches that the apparatus is related to a method for irradiating the human body with infrared radiation. (column 1, lines 6-19 of Kexin). Wilke et al. teaches that infrared sources tend to heat the body and it is desirable to separate the source from the sample. (column 1, line 64 to column 2, line 6 of Wilke). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of Kexin to separate the infrared source from the body tissue as disclosed by Wilke et al. since infrared sources tend to heat the body. In regard to claim 33, contact between the probe is minimized by preventing the

infrared source from touching the patient. In regard to claims 35-36, the structure 16a in Figs 7-8 of Kexin is mounted in the holes of base 60 (shown in Fig. 11 of Kexin) and is therefore considered part of the base. Structure 16a houses the optic fiber. In regard to claim 37, an arm is being examined. (Fig. 11 of Kexin). In regard to claim 45, presser member 64 is part of the wrist support which provides a plurality of contours and heights due to its malleable nature and the dimensions of the patient's arm. (Fig. 11 of Kexin). In regard to claim 46, the hand support is slideably adjustable. In regard to claim 48, Kexin does not explicitly teach that all the supports are custom-fabricated. Kexin teaches that different hand supports are prepared for different measuring tissues for higher accurate readings. (column 5, lines 21-29 of Kexin). Kexin implies that the hand support can be changed to accommodate a particular patient. The customization of a probe to a body part would also contribute to the patient's comfort during the measurements. The customization of the structure that holds the body part to a particular patient would ensure the patient's desired comfort and higher accurate readings while accommodating the different physical dimensions of each patient. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use customized supports in the combination since customization would ensure the patient's comfort and higher accuracy readings while accommodating the different physical dimensions of each patient.

12. Claims 40-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,026,313 to Kexin in view of U.S. Patent 6,039,697 to Wilke et al. as

applied to claims 38, and further in view of U.S. Patent 6,088,605 to Griffith et al., and further in view of U.S. Patent 5,195,985 to Hall. Kexin teaches an elbow support 62. (Fig. 11 of Kexin). Kexin does not teach that the elbow support includes a depression to accommodate the shape of the elbow. It is known in the art that when a specimen, such as an arm, is examined, the examining platform is configured to the shape of that specimen. For example, Griffith et al. teaches an apparatus in which an arm is set. (Fig. 1 of Griffith et al.). The depressions increase the patient's comfort when the arm is placed on the examining apparatus. (column 10, lines 50-52 of Hall). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of Kexin to include a depression to accommodate the elbow as disclosed in Griffith et al. since such a depression increases the comfort of the patient. It is well known that different specimens have different dimensions. An example is provided in Kexin which involves different probes for different sizes of hands. (column 5, lines 21-29 of Kexin). Using different sizes of elbow depressions would ensure the patient's comfort that is desired while accommodating the different physical dimensions of each patient. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the elbow depressions of the combination so as to have a plurality of different shapes available since using different sizes of elbow depressions would ensure the patient's comfort while accommodating the different physical dimensions of each patient.

13. Claim 43 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,026,313 to Kexin in view of U.S. Patent 6,039,697 to Wilke et al., and further in view of U.S. Patent 6,088,605 to Griffith et al., and further in view of U.S. Patent 5,195,985 to Hall as applied to claim 42, and further in view of U.S. Patent 3,785,196 to Smith. Kexin teaches the use of springs to adjust the elbow height. (Fig. 11 of Kexin). Kexin does not teach the use of shims or spacers to adjust the elbow height. It is well known in the art that spacers or shims are suitable substitutions for springs. (column 4, lines 18-21 of Smith). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to substitute the spacer of Smith for the spring since Smith teaches that are suitable substitutions for each other. A series of spacers would be necessary since Kexin teaches the elbow support is adjustable and different sizes of spacers would be needed to make the elbow support 62 adjustable.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew J Kremer whose telephone number is 703-605-0421. The examiner can normally be reached on Mon. through Fri. between 7:30 a.m. - 4:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Winakur can be reached on 703-308-3940. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-0758 for regular communications and 703-308-0758 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.



Matthew Kremer  
Assistant Examiner  
Art Unit 3736  
January 3, 2003



ERIC F. WINAKUR  
PRIMARY EXAMINER